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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,348	12/29/2000	Robert Drew Major	112024-0063	8415

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/752,348

Applicant(s)

MAJOR ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "being decrypted on the fly" in lines 14-15. It is not clear what "the fly" refers to.

Claim 3 recites the limitation "the selected encrypted digital content" in lines 16-17. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the encrypted digital content" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the downloads" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites "decryption of the selected digital content on the fly" in lines 10-11 of page 6. It is not clear what "the fly" refers to.

Claim 33 recites "decrypted on the fly" in line 3 of page 8. It is not clear what "the fly" refers to.

Claims 4-25, 27-32 and 34-38 are rejected for incorporating the errors of their respective base claims by dependency.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 33 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson, Jr., U. S. Patent 5,857,020.

As to claim 1, Peterson teaches an Internet Box Office (IBO) system adapted to vend multimedia content via a computer network to a consumer, the IBO system comprising (abstract):

- a) A content delivery networking (CDN) infrastructure of the computer network, the CDN infrastructure including deployment enhancements configured to provide cost effective downloading of the multimedia digital content over the network (column 2 lines 54-58);
- b) A viewing system coupled to the deployment enhancements of the CDN infrastructure, the viewing system capable of displaying the multimedia digital content to the consumer (abstract and column 3 line 63 – column 4 line 19 and Fig. 1);
- c) A digital rights management (DRM) system coupled to the viewing system, the DRM system functioning to authorize the multimedia digital content for viewing by the consumer (abstract and column 3 line 66 – column 4 line 19 and Fig. 1);

d) A digital content management system configured to store the multimedia digital content in encrypted form, the management system interacting with the deployment enhancements of the CDN infrastructure to deliver the encrypted content to the viewing system upon authorization by the DRM system (abstract and column 5 lines 34-65 and Fig. 1).

As to claim 33, Peterson teaches a method of use an Internet Box Office (IBO) system for vending copyright-protected multimedia digital content via a computer network to a consumer, the IBO system having a viewing system, a digital rights management system, and a digital content management system, the method comprising (abstract and Fig. 1):

- a) Finding and selecting, through cooperation of the viewing system and the digital content management system, multimedia digital content for playing back (abstract and column 2 line 54 – column 3 line 5 and column 4 line 63 – column 4 line 19 and Fig. 1);
- b) Downloading encrypted multimedia digital content from the digital content management system to the viewing system (abstract and column 5 lines 34-65 and Fig. 1);
- c) Displaying to the consumer, through the cooperation of the viewing station system and the digital rights management system, the copyrighted-protected multimedia digital content as the digital content is decrypted, and no decrypted version of the digital content is saved on the viewing system (abstract and

column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5 lines 44-65 and column 8 line 52 – column 9 line 3 and Fig. 1).

As to claims 35-38, Peterson teaches at least one node for carrying out the method, instruction and data containing for the practice of the method, and electromagnetic signals traveling over a computer network carrying information for the practice of the method (Fig. 1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, Jr., U. S. Patent 5,857,020 in view of Hendricks et al., U. S. Patent 5,798,785.

As to claim 2, Peterson teaches a server is coupled to the viewing system to allowing the user to purchase and view a selected digital content (abstract). Peterson does not specifically teach the server organizes titles of the multimedia digital content for browsing by the consumer when selecting the content. However, Hendricks teaches a server categorizes titles of the multimedia digital content for browsing by the consumer when selecting the content (Figs. 11a-11e). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital content of Peterson to be categorized by titles because it would allow the user to easily find a desired digital content.

As to claim 3, Peterson teaches an Internet Box Office (IBO) system for vending digital content via a computer network to a consumer, the IBO system comprising (abstract):

- a) A viewing system, the viewing system being in electronic communication with the computer network and the viewing system having a user interface (abstract and column 3 line 63 – column 4 line 19 and Fig. 1);
- b) A movie management system in electronic communication with the viewing system through the computer network, the movie management system having a play list manager and allowing the user to view a selected digital content (abstract and column 6 lines 27-41 and Fig. 1);
- c) A rights management (DRM) system for granting a right to view a selected digital content, the right to view being granted by downloading to the viewing system a decryption key enabling decryption of the selected digital content

(abstract and column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5 lines 44-65 and Fig. 1);

d) A display for viewing the selected digital content downloaded from the movie management system to the viewing system, the selected digital content being decrypted, through use of the decryption key downloaded from rights management system to the viewing system, so that no decrypted version of the selected encrypted digital content is stored on the viewing system (abstract and column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5 lines 44-65 and column 8 line 52 – column 9 line 3 and Fig. 1).

Peterson does not specifically teach the play list manager having a list of titles of the digital content available for viewing and selected through the user interface.

However, Hendricks teaches this matter (Figs. 11a-11e). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the play list manager of Peterson to include a list of titles of the digital content because it would allow the user to easily find a desired digital content.

As to claim 4, Peterson further teaches a billing system for accepting payment through the viewing system for the right to view, and the billing system applying a discount to the consumer (abstract and column 3 lines 7-35). Peterson does not specifically teach applying a discount if the consumer has agreed to view digital content in addition to the selected digital content. It would have been obvious to one of ordinary skill in the art to allow the billing system of Peterson to include this commonly used sale



strategy (i.e. rent one get the second one half price) for promoting faster sell of the digital contents.

As to claim 5, Peterson teaches the digital content further comprises interactive digital content, movies, ads, and trailers (abstract).

As to claim 6, Peterson teaches the viewing system receives from the movie management system information in advance of a predetermined premier event date (column 7 lines 41-43). Peterson does not specifically teach the viewing system receives from the movie management system and displays to the consumer information about the status of the digital content being downloaded. However, Hendricks teaches this matter (column 20 line 6 – column 21 line 45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the viewing system of Peterson to receive the status of the digital content being downloaded because it would allow the consumer to easily view the status of the desired digital content.

As to claim 7, Peterson teaches the right management system protects the decrypted key during a fixed length of time and ensures that the decryption key expires after the fixed length of time (column 8 lines 52 – column 9 line 20 and Fig. 3).

As to claim 8, Peterson teaches the right management system provides usage tools for controlling interface between the consumer and the digital content, and tracking tools for use and distribution of the digital content (column 3 lines 6-35 and Figs. 1, 3).

As to claim 9, Peterson teaches secured and managed communication through the computer network to protect the rights of an owner of the digital content (abstract and Fig. 1).

As to claim 10, Peterson teaches a policy management process for leasing the digital content, a monitoring process for monitoring adherence to the lease of the digital content, and a purging process for erasing the downloaded digital content when the lease expires (column 3 lines 6-35 and column 8 line 52 – column 9 line 3 and column 10 lines 4-19 and Figs. 1, 3).

As to claims 11-16 and 20, Peterson does not specifically teach the movie management system has a plurality of movie studio web servers, the movie studio web servers are located at a plurality of web sites, optimally schedule downloading of the selected digital content, using a cache local to viewing system. However, Hendricks teaches these matters (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Peterson to include these features because it would allow consumer to request various types of digital contents and it would also allow the consumer to fast access the requested digital contents.

As to claim 17, Peterson does not specifically teach a screen saver function. However, screen saver function is well known in the art and it is also commonly used. It would have been obvious to one of ordinary skill in the art to allow the system of Peterson to include this commonly used feature of screen saver so that it provides pleasant view to consumer during downloading.

As to claim 18, Peterson teaches the digital content is copyrighted; a managed storage system for storing the encrypted digital content on the viewing system in encrypted form (abstract and column 5 lines 34-65 and Fig. 1).

As to claim 19, Peterson teaches a feature permitting the consumer to choose a time at which to view the downloaded digital content (column 4 line 20 – column 5 line 3).

As to claim 21-22, Peterson modified by Hendricks as discussed above further teaches transmitting interruption signals (Hendricks: column 2 lines 55-61 and column 25 line 42 – column 27 line 24). Peterson modified by Hendricks does not specifically teach automatically resumes an interrupted download operation, and the downloads are queued so that the computer network substantially maintains its pre-download performance. It would have been obvious to one of ordinary skill in the art to allow the downloading method of Peterson modified by Hendricks to include automatically resuming an interrupted download operation, and the downloads are queued for maintaining the pre-download performance because it would allow method of Peterson modified by Hendricks for fast and efficiently downloading digital contents.

As to claim 23, Peterson modified by Hendricks as discussed above further teaches tracking the consumer's usage history (Peterson: column 11 lines 1-4; Hendricks: column 13 lines 56-58 and column 22 lines 14-21). Peterson modified by Hendricks does not specifically teach allowing the consumer to specify a maximum number of trailers to download for each movie downloaded. It would have been obvious to one of ordinary skill in the art to allow tracking method of Peterson modified by Hendricks to include the feature of allowing the consumer to specify a maximum number of trailers to download for each movie downloaded for suiting the best interest of the consumer in terms of obtaining the trailers.

As to claims 24-25, Peterson modified by Hendricks as discussed above further teaches the user interface is a web browser and providing a accommodate streaming video media (Figs. 2, 11a-11e).

Claims 26-32 are rejected for the similar reasons as claims 3-4.

Claim 34 is rejected for the similar reasons as claims 6 and 21-22.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morales (U. S. Patent 5,291,554) discloses movies and like video programs are distributed electronically from a program storage and processing center in encrypted format over a satellite channel upon custom order for private viewing of one paying subscriber or a small group of subscribers.

Wonfor et al. (U. S. Patent 6,381,747) discloses providing copy protection of video analog and digital signals and the like, wherein the signals are transmitted via a digital delivery network, and may comprise, for example, pay per view (PPV) program materials protected by copyrights of respective program rights holders.

Yamanaka (EP 0 975 111 A2) discloses TV music broadcasting program is distributed from a distribution apparatus through a ground station and a satellite, and a musical-piece program is also distributed through a plurality of audio channels. A subscriber looks for the desired musical piece from a musical-piece list displayed on the screen of a TV receiver and downloads it into a storage device. A pay-per-view method is employed in which accounting is performed in units of musical pieces.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687      (Official Communications; including After Final  
Communications labeled "BOX AF")  
(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
March 7, 2003



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